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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,826	02/24/2002	Alan P. Wolfe	8325-0014.20	4340

7590 07/28/2004

ROBINS & PASTERNAK LLP
Suite 200
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Menlo Park, CA 94025

EXAMINER

AKHAVAN, RAMIN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Applicant 07/26/04 RS

Office Action Summary	Application No.	Applicant(s)
	10/084,826	WOLFFE ET AL.
Examiner	Art Unit	
Ramin (Ray) Akhavan	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 February 2002.
2a) This action is FINAL. 2b) This action is non-final.
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7,10-36 and 40-73 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) _____ is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) 1-7,10-36 and 40-73 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 10-11, 14, 19 and 73, drawn to a method of binding or modifying a region of interest in cellular chromatin with a fusion molecule, classified in 435, subclass 6.
- II. Claims 1, 12, 13, 19-33 and 44-71, drawn to a method of modulating gene expression, classified in 435, subclass 455.
- III. Claim 72, drawn to a method of producing a fusion polypeptide in a suitable host cell, classified in class 435, subclass 69.1.
- IV. Claims 34-36 and 40-43, drawn to a fusion molecule and cells comprising said fusion molecule, classified in class 530, subclass 350.

Inventions in Groups I and II are unrelated inventions. Each group is drawn to a biologically and patentably distinct method directed to a specific outcome. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Group I and II are not necessarily capable of use together, as is evident from the prescribed claimed outcome; For example, a method of detection of a gene of interest is not necessarily capable of use in concert with a method of modulating gene expression. Thus binding chromatin with the object of modifying chromatin is biologically and patentably distinct from modulating gene expression.

Inventions in Group IV and Groups I-II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used for a materially different process of raising antibodies, for example.

Inventions III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the fusion product could be made chemically or synthetically.

Claims 1 and 19 link inventions in Group I and II. The restriction requirement for the linked inventions is subject to the nonallowance of the linking claims, claims 1 and 19. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claim depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

For the reasons given above these inventions are distinct and have acquired a separate status in the art as shown by their different classification. In addition, each group would require a separate search, thus restriction for examination purposes as indicated is proper. Applicant is advised that a reply to this restriction requirement must include an election for the invention (i.e. Group I or II or III or IV) to be examined, for the reply to be complete, notwithstanding that the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if none or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

The pending claims 1-7, 10-36 and 40-73 are subject to a restriction requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramin (Ray) Akhavan whose telephone number is 571-272-0766. The examiner can normally be reached on Monday- Friday from 8:00-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ray Akhavan/AU 1636

Gerry Leffers
GERRY LEFFERS
PRIMARY EXAMINER

RE/SEN

TC1600

Organization _____
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